

REMARKS

Reconsideration of the present application is respectfully requested. No new matter has been added. Claims 1–15 remain pending in the application. Claims 16 and 17 have been cancelled.

Rejections Based on 35 U.S.C. § 103

Claims 1–8, 11, and 13–14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mielke U.S. 3,872,935 in view of Kaczerwaski U.S. 4,611,350. Applicants respectfully traverse this rejection because the instant invention is not taught or rendered obvious by Mielke in view of Kaczerwaski.

In order to rely on a reference under 35 U.S.C. § 103(a), it must be analogous prior art. *See* MPEP § 2141.01(a). “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *Id.* (citing *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992)). A reference is reasonably pertinent if one of ordinary skill in the art, seeking to solve a particular problem or problems, would reasonably be expected or motivated to look to the allegedly analogous art. *See id.*

Kaczerwaski is directed to “liners for various containers such as waste baskets, garbage cans and the like.” (Kaczerwaski, col. 1, ll. 9–11). Kaczerwaski is not in the field of Applicants’ endeavor (soil sampling) and is not pertinent to the particular problems with which Applicants were concerned (for example, providing a soil sampler liner having sufficient strength while, at the same, allowing a user to readily remove a soil sample from the liner). Further, one skilled in the art of soil sampling would have no motivation to consult patents on

liners for waste baskets or garbage cans. For example, Kaczerwaski notes that “plastic bag liners are normally made of *extremely thin* gauge plastic.” (Kaczerwaski col. 2, ll. 22–23) (emphasis added). In contrast, the instant invention deals with “larger [soil] samples [that] call for liners with *relatively thick* walls that can withstand the axial and radial forces imposed upon the liner by the insertion process and the soil sample itself.” (Page 1, specification). Moreover, the Office Action, in support of the § 103(a) rejection, states that “Kaczerwaski shows that it is known to make *flexible* liners with an area of reduced thickness to facilitate *insertion for a snug fit of the liner.*” (Office Action mailed April 16, 2003, p. 3, para. 6) (emphases added). In contrast, the instant invention deals with liners that are “*relatively rigid*” (page 1, specification) yet have areas of reduced wall thickness “to permit a user to easily and safely cut through the wall at the reduced wall area and expose the soil sample contained within the liner.” (pages 1–2, specification). For the aforementioned reasons, Applicants respectfully submit that Kaczerwaski is not analogous art that may properly be considered in rejecting the claims of the instant applicant.

Further, the test for obviousness is whether the combined teachings of the prior art, taken as a whole, suggest the modifications to the person of ordinary skill in the art. *In re Napier*, 55 F.3d 610, (Fed. Cir. 1995). “Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.” *Carella v. Starlight Archery*, 804 F.2d 135 (Fed. Cir. 1986).

One problem providing inspiration for the instant invention was the difficulty (and danger) presented in cutting through the liners used in soil sampling, especially considering that such liners often must be relatively thick to withstand the applied forces. (Pages 1–2,

specification). Kaczerwaski nowhere addresses this problem and would therefore not be helpful to one skilled in the art of soil sampling, even were it deemed analogous art. Rather, the focus of Kaczerwaski is keeping trash and waste inside the liner. (Kaczerwaski at col. 1, ll. 11–16). Similarly, Mielke nowhere addresses the problem of removing soil samples from relatively rigid soil sampler liners. To the contrary, Mielke teaches a flexible, heat-shrinkable plastic lining and teaches away from using rigid wall sample containers. (Mielke, col. 1, ll. 34–36; col. 3, ll. 7–21).

Finally, all claim limitations must be considered, especially when a limitation essential to the invention is missing from the prior art. *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). In *In re Fine*, the Federal Circuit held that a reference did not render the claimed invention obvious because the examiner ignored a material, claimed temperature limitation which was absent from the prior art reference. *Id.* at 1075–76. Accordingly, even if Mielke is combined with Kaczerwaski, the combination does not disclose all of the limitations of claim 1 or dependent claims 2–15. Neither Mielke nor Kaczerwaski teach, for example, “reduced areas extending along at least a portion of the length of said member” as recited in claim 1 of the instant application. (Page 7, claim 1) (emphasis added).

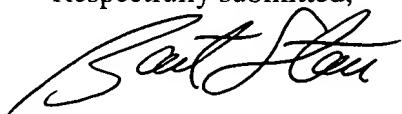
In view of the above arguments, Applicants respectfully submit that claims 1–8, 11, and 13–14 are not obvious over Mielke in view of Kaczerwaski. The objection to claims 9–10, 12, and 15 as being dependent upon a rejected base claim also is hereby traversed.

Conclusion

For the reasons stated above, Applicants respectfully submit that claims 1–15 are now in condition for allowance. Applicants respectfully request withdrawal of the pending rejections and allowance of claims 1–15. If any issue remains which would prevent issuance of this application, the Examiner is urged to contact the undersigned prior to issuing a subsequent

action. The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-2112.

Respectfully submitted,



Bart A. Starr
Registration No. 48,386
SHOOK, HARDY & BACON, L.L.P.
One Kansas City Place
1200 Main Street
Kansas City, MO 64105-2118
(816) 474-6550 Telephone
(816) 421-5547 Facsimile